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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/785,195 | 02/25/2004 | Toshihiro Matsuura | 016891-0865 | 3378 |
| 22428 | 7590 | 09/30/2005 | EXAMINER | |
| FOLEY AND LARDNER SUITE 500 3000 K STREET NW WASHINGTON, DC 20007 | | | LE, UYEN CHAU N | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2876 | |

DATE MAILED: 09/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/785,195 | Applicant(s) MATSUURA, TOSHIHIRO | |
| | Examiner Uyen-Chau N. Le | Art Unit 2876 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 3-11, 13 is/are allowed.
- 6) ☒ Claim(s) 1,2,12 and 14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>02/04, 06/05</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Objections

2. Claims 1-3, 5-6 and 12-14 are objected to because of the following informalities:

Re claim 1, line 7: Substitute "amerchandisemanagement server to which said merchandisemanagement terminal is connected" with -- a merchandise management server to which said merchandise management terminal is connected --.

Re claim 2, line 11: Substitute "the password are identical and the account settlement" with - the password are identical and the account settlement --.

Re claim 3, lines 5-6: Substitute "and amerchandisemanagement server to which said merchandisemanagement terminal is" with - and a merchandise management server to which said merchandise management terminal is --.

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Re claim 3, line 25: Substitute "it" with -- ordering information --.

Re claim 3, line 31: Substitute "formanagingtheinventory volumeofeachmerchandise item" with - for managing the inventory volume of each merchandise item--.

Re claim 3, line 34: Substitute "saidusermobile terminal" with - said user mobile terminal --.

Re claim 3, line 40: Substitute "notifiedbysaidmerchandise" with - notified by said merchandise --.

Re claim 3, line 41: Substitute "ofauthentication orin the case of cash payment, fortransmitting" with - of authentication or in the case of cash payment, for transmitting --.

Re claim 5, line 11: Substitute "thepasswordareidenticalandtheaccountsettlementinformation" with - the password are identical and the account settlement information --.

Re claim 6, line 4: Substitute "usermobileterminalhas meansforperforminginfrared" with - user mobile terminal has means for performing infrared --.

Re claim 12, line 10: Substitute "formanagingtheinventoryvolume ofeachmerchandise" with - for managing the inventory volume of each merchandise --.

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Re claim 12, line 12: Substitute "eachmerchandise item at a request from said usermobile terminal" with each merchandise item at a request from said user mobile terminal --.

Re claim 13, line 13: Substitute "it" with - said program -
-.

Re claim 13, line 22: Substitute "inventoryvolumeofeachmerchandiseitemreceivessaidactuation" with - inventory volume of each merchandise item receives said actuation --.

Re claim 13, line 31: Substitute "whetherthepayment methodcontainedinsaidorderinginformation" with - whether the payment method contained in said ordering information --.

Re claim 13, line 57: Substitute "andsaidorderinginformationpertainingtothealreadycompleted" with - and said ordering information pertaining to the already completed --.

Re claim 14, line 11: Substitute "inventoryvolume ofeach" with - inventory volume of each --.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

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3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Takahashi et al (JP 2002-215914).

Re claim 1: Takahashi et al discloses a sales system comprising user mobile terminals 4a, each owned by a train passenger, for storing an in-train merchandise purchase program; salesperson terminals each borne by a salesperson in the train 1 (i.e., a missionary salesman 7 possesses the pocket sales management terminal 14 and the DEBITTO terminal 9); a merchandise management terminal 2 connected to the user mobile terminals 4a and the salesperson terminals 7 via a network 4 in the train; and a merchandise management server (i.e., host 13) to which the merchandise management terminal is connected via the Internet; wherein:

the merchandise management terminal has:

means, upon receiving ordering information entered from the user mobile terminal in accordance with the in-train merchandise purchase program, for discerning the payment method and, for

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transferring the ordering information to the salesperson terminal if the payment method is cash payment; and

means, for requesting the merchandise management server to give authentication if the payment method is any other method than cash payment and, for transferring the ordering information to the salesperson terminal if authentication is given; and

the merchandise management server has means for settling account with the passenger requiring any non-cash payment method when notified by the salesperson terminal of the completion of a sale via the merchandise management terminal. (See English abstract and English translation, paragraphs [0005-0021])

Re claim 2: wherein the merchandise management server has authenticating means, upon receiving a request for authentication from the merchandise management terminal, for checking whether the name and the password contained in the ordering information are identical with the respective ones registered in advance as personal information; for discerning whether account settlement information matching the payment method contained in the ordering information is contained in the pertinent personal information and, for giving authentication if both the name and the password are identical and the account settlement information is registered (English translation, paragraphs [0019-0021]).

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Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi et al in view of Iwase et al (US 2002/0165803). The teachings of Takahashi et al have been discussed above.

Re claims 12 and 14: Takahashi et al has been discussed above but is silent with respect to means for managing the inventory volume of each merchandise item and transmitting the inventory volume of each merchandise item at a request from the user mobile terminal.

Iwase et al teaches a system comprising a portable device possessed by a user and a host computer for communication with the portable device, the host computer comprising: memory means for storing the number of inventories of each of commodities placed in the shop, and substitute commodity information corresponding to each commodity; first acquisition means for

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acquiring, when a commodity inventory inquiry request has been received from the portable device, the number of inventories of the associated commodity by searching the memory means; first transmission means for transmitting to the portable device the information on the number of inventories of the commodity acquired by the first acquisition means (paragraph [0011] and claim 6).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Iwase et al into the system as taught by Takahashi et al in order to provide the customer with an exact number of items/products available for ordering/purchasing, preventing the customer from ordering out-of-stock items, thus reducing time and labor.

Allowable Subject Matter

7. Claims 3-11 and 13 would be allowable if rewritten or amended to overcome the objection(s) set forth in this Office action.

8. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of records and all other cited references, taken alone or in combination, fails to teach or fairly suggest

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the specific structure and method of registering in advance with the merchandise management server personal information including the name, password and account settlement information by the user mobile terminal; downloading an in-train merchandise purchase program from the merchandise management server and storing it in advance in the user mobile terminal as set forth in the claimed combination.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The patents to Mueller et al (US 5235509 A); Montague et al (US 5504589 A); Green et al (US 5664110 A); Camaisa et al (US 5845263 A); Pentel (US 5969968 A); Kinebuchi et al (US 6208976 B1); Hataguchi (US 20010029472 A1); Ueno et al (US 20010051915 A1); Sugukawa et al (US 20020020743 A1); Parry et al (US 20020091577 A1); Hammond et al (US 20020133418 A1); Showghi et al (US 6473739 B1); Chen et al (US 20030050095 A); Bunce (US 20040122685 A1); Showghi et al (US 6920431 B2) are cited as of interest and illustrate a similar structure to a sales system, sales management terminal and program for selling goods aboard train.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 571-272-2397. The examiner can normally be reached on First Monday 5:30AM-1:30PM and Tues-Fri 5:30AM-3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Uyen-Chau N. Le
Examiner
AU 2876

September 23, 2005